

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

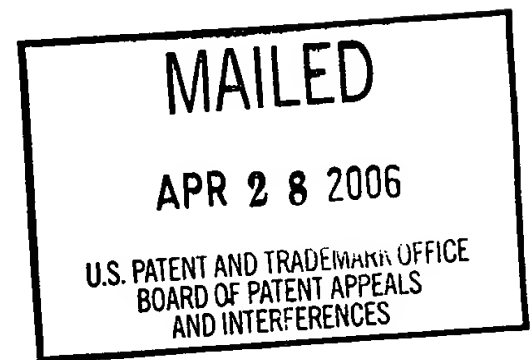
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANDREAS BLECKMANN,
RAINER KROPKE, and GUNTHER SCHNEIDER

Appeal No. 2005-1742
Application No. 09/436,171

ON BRIEF



Before ELLIS, MILLS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-5, 7-9 and 11. Claim 1 is representative of the subject matter on appeal, and is drawn to a water-in-oil emulsion, "(a) with a content of water and optionally water-soluble substances totalling greater than 85% by weight, and with a content of lipids, emulsifiers and lipophilic constituents of less than 15% by weight, in each case based on the total weight of the preparations," "(b) comprising at least one surface active substance selected from the group consisting of substances of the general formula (I)," and

“(c) additionally comprising at least one cationic polymer, wherein said at least one cationic polymer is selected from the group consisting of cationic cellulose derivatized with a quaternary ammonium salt, cationic starch, copolymers of diallylammonium salts and acrylamides, quaternized vinylpyrrolidone/vinylimadazole polymers, condensation products of a polyglycol with an amine, quaternized collagen polypeptides, quaternized wheat polypeptides, polyethyleneimine, cationic silicone polymers, copolymers of adipic acid with dimethylaminohydroxypropyldiethlenetriamine, copolymers of acrylic acid with dimethyldiallylammonium chloride, polyaminopolyamides, and cationic guar gum.”

The examiner relies upon the following references:

Yoneyama et al. (Yoneyama)	5,015,469	May 14, 1991
Dupuis et al. (Dupuis)	6,338,858	Jan. 15, 2002
Schreiber et al. (Schreiber I)	6,613,338	Sep. 2, 2003
Schreiber et al. (Schreiber II) ¹	WO 98/17232	Apr. 30, 1998

Claims 1, 3, 5, 7-9 and 11 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Schreiber II and Dupuis. In addition, claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Schreiber II and Dupuis as further combined with Yoneyama.

¹ Note that Schreiber I is apparently the English equivalent of the Schreiber II reference, see Examiner's Answer, page 3, and Schreiber I does claim priority to the Schreiber II reference.

After careful review of the record and consideration of the issues before us, we reverse.

DISCUSSION

Claims 1, 3, 5, 7-9 and 11 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Schreiber II and Dupuis.

Schreiber II is cited for teaching “water-in-oil emulsions comprising 30-85% of an aqueous phase, and preferably 1-20% of a lipid phase and a surface active substance of formula (I) The reference lacks cationic polymers.”

Examiner’s Answer, page 3.

Dupuis is cited for teaching water-in-oil emulsions for use in cosmetic products. See id. Dupuis teaches the use of cationic polymers comprising 0.001-5% of the composition, wherein the cationic agents are used as conditioning agents. See id. at 3-4.

The rejection concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the cationic polymers of Dupuis [] to the compositions of Schreiber [] because a) Schreiber [] and Dupuis [] are both directed to cosmetic water-in-oil stick emulsions, wherein lipsticks are specifically exemplified; b) Dupuis [] teach[es] that adding cationic polymers to such emulsions results in a conditioning effect; hence, one of ordinary skill in the art would be motivated to add the cationic polymer taught by Dupuis [] into the composition of Schreiber [] because of the expectation of achieving a composition that imparts conditioning benefits to the skin, especially the lips.

Id. at 4.

“[T]he Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ‘[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citation omitted). An adequate showing of motivation to combine requires “evidence that ‘a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.’” Ecolochem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

Appellants argue “the difference of having an aqueous phase greater than 85% by weight . . . is not addressed by the combination of references and on this basis alone, there is no prima facie [case] of obviousness.” Appeal Brief, page 8. Specifically, according to appellants, “Schreiber caps the amount of aqueous phase at an amount less than that claimed by appellants and Dupuis discloses nothing that would suggest increasing the amount of aqueous phase beyond 85% by weight even if it could be shown that Dupuis suggested the inclusion of cationic polymers to Schreiber.” Id. We agree, and the rejection is reversed.

Claim 1 requires a water-in-oil emulsion, “with a content of water and optionally water-soluble substances totaling greater than 85% by weight.” The examiner relies on Schreiber to meet that limitation, stating that “Schreiber []

teach[es] water-in-oil emulsions comprising 30-85% of an aqueous phase.”

Examiner’s Answer, page 3. The examiner asserts further that “the claim limitation merely requires the amount of the aqueous phase comprising water and water-soluble substance be greater than 85%. Schreiber teaches that its solid composition may comprise up to 85% of water, and applicants’ limitation ‘greater than 85%’ can be, for example, 85.001%. The claimed weight limitation of the aqueous phase is thus rendered obvious by the teachings of Schreiber.” Id. at 6.

The examiner misstates the issue. Admittedly, “greater than 85%” reads on an amount of 85.001% by weight. Schreiber I, however, teaches that “[t]he amount of water can be up to about 85% by weight, based on the total weight of the preparations, optimum water contents usually being chosen in the range between 50 and 75% by weight.” Id. Col. 10, lines 1-4. Thus, Schreiber I does not teach or suggest amounts greater than 85%. Thus, the issue becomes does Schreiber I provide motivation to prepare water-in-oil emulsion, “with a content of water and optionally water-soluble substances totaling greater than 85% by weight?”

The examples in Schreiber I, however, do not even approach a content of water and optionally water-soluble substances totaling greater than 85% by weight.² Moreover, the examiner has not pointed to any teachings in either Schreiber I or Dupuis that would motivate the ordinary artisan increase the

aqueous phase to greater than 85%. Thus, one of ordinary skill in the art, when considering the combined teachings as a whole, would not have been motivated by the combination of references to prepare a water-in-oil emulsion, "with a content of water and optionally water-soluble substances totaling greater than 85% by weight."

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious over the combination of Schreiber and Dupuis, as further combined with Yoneyama.


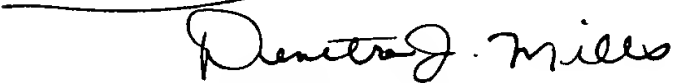
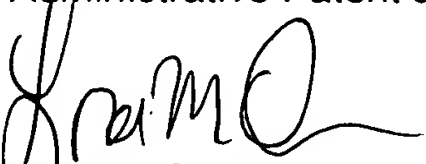
Yoneyama is cited for teaching "water-in-oil emulsion type cosmetics comprising cationic surfactants. Hydrocarbon oils such as liquid paraffin, isopropyl myristate, waxes such as petrolatum, and silicone oils are disclosed as comprising the oil components." Examiner's Answer, page 4. Thus, Yoneyama does not remedy the deficiencies of the combination of Schreiber and Dupuis, and the rejection of claim 4 is also reversed.

² We also note that the claims in Schreiber are limited to "an aqueous phase which comprises . . . from 50 to 75% by weight of water"

CONCLUSION

Because the examiner has failed to set forth a prima facie case of obviousness, the rejection of claims 1, 3-5, 7-9 and 11 under 35 U.S.C. § 103(a) as being obvious over the combination of Schreiber and Dupuis, and the rejection of claim 4 stands under 35 U.S.C. § 103(a) as being obvious over the combination of Schreiber and Dupuis as further combined with Yoneyama, are reversed.

REVERSED

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Joan Ellis)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
Demetra J. Mills)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
Lora M. Green)	
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